

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional) 8285/476

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail 906856484US in an envelope addressed to: "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a)).

On November 9, 2006

Signature

Typed or printed

Name Scott W. Brim

Application Number

09/990,761

Filed November 16, 2001

First Named Inventor Claire Svetlana Vishik et al.

Art Unit

2157

Examiner

Martin, Ciara A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five(5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 51,500

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.

Signature

Scott W. Brim

Typed or Printed Name

312 321-4200

Telephone number

Note: Signatures of all inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

November 9, 2006

Date

☒ *Total of 1 forms are submitted.

Express Mail Label No.: EV 906856541US

Date of Deposit: November 9, 2006



Attorney Docket No. 8285/476

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Claire Svetlana Vishik et al.

Serial No.: 09/990,761

Filing Date: November 16, 2001

For: Method and System for Intelligent
Routing Based on Presence
Detection

)
)
)
) Examiner: Martin, Ciara A.
)
) Group Art Unit No.: 2157
)
)
)
)
)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandra, VA 22313-1450

Dear Sir:

Applicants requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

REMARKS

I. Introduction

Claims 1-30 are pending in the application. In the final Office Action dated Aug. 9, 2006, the Examiner rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,263,064 ("O'Neil") in view of U.S. Pat. App. Pub. No. 2002/0036505 A1 ("McDowell"). Applicants respectfully request review of the final rejection.

II. The Proposed Combination Does Not Render Claim 1 Unpatentable

Independent claim 1 recites routing a message which is to be routed to one of a plurality of authorized parties to an active communication device associated with a second authorized party in response to determining that a presence of a first authorized party remains undetected and detecting the presence of a second authorized party. O'Neil and McDowell fail to disclose at least this element.

The Examiner has admitted that O'Neil does not disclose detecting the presence of a first or a second authorized party. Therefore, O'Neil necessarily cannot disclose performing actions in response to detecting the presence of a first or second party. The only reference cited by the Examiner that discloses detecting the presence of a user is McDowell.

McDowell is directed to a system that provides advertisements to instant messaging users based on a detected presence of the instant messaging user. Generally, the McDowell system detects whether a user is present, and if present, then sends an advertisement to the user. In other words, McDowell discloses a system that sends a plurality of advertisements to a plurality of potential customers who are currently online. McDowell does not disclose routing a message ***in response to determining that a presence of a first authorized party remains undetected and detecting the presence of a second authorized party*** as recited in independent claims 1. In McDowell, a message is sent to the user independent of whether another party is present or not.

In the final office action, the Examiner cites paragraphs [0052], [0083], [0092], and [0096] of McDowell as disclosing routing a message which is to be routed to one of

a plurality of authorized parties to an active communication device associated with a second authorized party in response to determining that a presence of a first authorized party remains undetected and detecting the presence of a second authorized party. Applicants respectfully disagree. Paragraph [0052] discloses a presence server that enables presence management so that subscribers may direct calls, messages, and data traffic to particular devices. Paragraph [0083] discloses location-sensitive web browsing where a location of a subscriber is forwarded to a web service. Paragraph [0092] discloses instant messaging through a WAP client or through two-way SMS wherein a user may read and compose instant messages, create and manage buddy lists and groups, and observe real-time buddy status. Paragraph [0096] discloses sending messages and buddy list information to mobile buddies. None of the cited paragraphs disclose performing actions ***in response to determining that a presence of a first authorized party remains undetected and detecting the presence of a second authorized party*** as recited in independent claims 1.

Further, in McDowell, an advertisement is sent to all parties whose presence has been detected. There is no single message that is being routed to one party as in the independent claims. The McDowell system is not attempting to send a single message intended for a group of people, to a single person in response to detecting the presence of that single person. The McDowell system is sending an advertisement to a plurality of users.

Because O'Neil and McDowell fail to disclose at least routing a message which is to be routed to one of a plurality of authorized parties to an active communication device associated with a second authorized party ***in response to determining that a presence of a first authorized party remains undetected and detecting the presence of a second authorized party***, the proposed combination of O'Neil and McDowell as contemplated by the Examiner necessarily does not render independent claim 1, or any claim that depends on claim 1, unpatentable. Applicants respectfully request review of the final rejection.

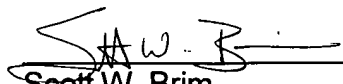
III. The Proposed Combination Does Not Render Claim 11 Unpatentable

Independent claim 11 recites a computer system to route a message which is to be routed to one of a plurality of authorized parties to an active communication device associated with a second authorized party ***in response to determining that the presence of a first authorized party remains undetected and detecting the presence of a second authorized party***. As explained above, O'Neil and McDowell fails to disclose this element. For at least this reason, the proposed combination of O'Neil and McDowell as contemplated by the Examiner necessarily does not render claim 11, or any claim that depends on claim 11, unpatentable. Applicants respectfully request review of the final rejection.

IV. The Proposed Combination Does Not Render Claim 21 Unpatentable

Independent claim 21 discloses a computer-readable medium having computer-readable program code to direct a computer to perform the act of routing a message which is to be routed to one of a plurality of authorized parties to an active communication device associated with a second authorized party ***in response to determining that a presence of a first authorized party remains undetected and detecting the presence of the second authorized party***. As discussed above, O'Neil and McDowell fail to disclose at least this element. For at least this reason, the proposed combination of O'Neil and McDowell as contemplated by the Examiner necessarily does not render claim 21, or any claim that depends on claim 21, unpatentable. Applicants respectfully request review of the final rejection.

Respectfully submitted,



Scott W. Brim
Registration No. 51,500
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200